REMARKS

Reconsideration of the Office Action mailed February 19, 2004, (hereinafter "instant Office Action"), entry of the foregoing amendments and withdrawal of the rejection of claims 1-114, 116-120, 124, 125 and 127-138, are respectfully requested.

In the instant Office Action, claims 1-114, 116-120, 124, 125 and 127-138 are listed as pending and claims 1-114, 116-120, 124, 125 and 127-138 are listed as rejected.

The Examiner noted that there are two claim 37 and claim 35 is missing in the set of claims filed January 22, 2004. Applicants acknowledge the numbering of the claims by the Examiner and in the foregoing claim set the numbering reflects the corrected claim numbers.

Applicants gratefully acknowledge that the rejections of claims 1-138 under 35 U.S.C. §112, first and second paragraph (Paper No. 11, paragraphs 3-4, 5a, 5c-5f and 5h-5i) have been obviated.

The Examiner noted that the Abstract is still defective because there is no definition for variable G. Applicants have amended the Abstract to follow the guidelines pointed out by the Examiner. The replacement of the pending Abstract with the replacement Abstract is effected by the amendment hereinabove.

The Examiner has rejected Claim 40 under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for many of the diseases listed in claim 120, allegedly does not reasonably provide enablement for an ocular condition, cancer, chronic inflammation, inflammatory bowel disease, Lyme Disease, cardiovascular condition, stroke and human immunodeficiency virus. Without conceding the correctness of the Examiner's rejections and for the sole purpose of advancing the prosecution of the instant application to place it in condition for allowance, Applicants have amended claim 40 to delete ocular condition, cancer, chronic inflammation, inflammatory bowel disease, Lyme Disease, cardiovascular condition, stroke and human immunodeficiency virus, without waiver or prejudice to Applicants' right to file a continuation application directed to the cancelled subject matter.

Accordingly, the rejection of claim 40 under 35 U.S.C. §112, first paragraph, is obviated and should be withdrawn.

The Examiner has rejected Claim 120 under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for many of the diseases recited in claim 120, allegedly does not reasonably providing enablement for the treatment of inflammatory bowel disease, Lyme disease, human immunodeficiency virus and solid tumor. Without conceding the correctness of the foregoing rejection and for the sole purpose of advancing the prosecution of the instant application to place it in condition for allowance, Applicants have amended claim 120 to delete inflammatory bowel disease, Lyme disease, human immunodeficiency virus and solid tumor, without waiver or prejudice to Applicants' right to file a continuation application directed to the canceled subject matter. Accordingly, the rejection of claim 120 under 35 U.S.C. §112, first paragraph, is obviated and should be withdrawn.

The Examiner has rejected Claims 36, renumbered as claim 35, and 115 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner states "There has been recited a method of affecting hyperproliferative disorders, but the specification does not teach the method of affecting of the said disorder". Without conceding the correctness of the foregoing rejection and for the sole purpose of advancing the prosecution of the instant application to place it in condition for allowance, Applicants have cancelled claim 36, which is renumbered to claim 35 in the attached listing of claims. Applicants respectfully point out the claim 115 was cancelled in the Reply filed on August 22, 2003. Based upon the foregoing, the rejection of Claims 36, renumbered as claim 35, and 115 under 35 U.S.C. §112, first paragraph, is obviated and should be withdrawn.

The Examiner has rejected claims 36-37 and 120 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. The Examiner alleges that in claim 1 (page 4, line 6) or elsewhere in the claims, the phrase "Z^{110}...an optionally substituted (C_1-C_6) which..." is not clear. The Examiner asks whether it is (C_1-C_6) alkyl or something else. The Examiner raises the same questions for the phrase "Z^{105}...covalent bond or (C_1-C_6) which..." on page 5, line 14 and "Z^{200}...substituted or unsubstituted (C_1-C_6) which..." on page 5, lines 15-16.

The Examiner states that Applicants' argument filed 01/22/2004 has been fully considered but it is not persuasive.

The Examiner notes that "Applicants argue the rejection by referring to page 66, lines 3-5 of the specification. Said page does not mention any (C_1-C_6) groups." In a telephone conversation on May 18, 2004, the Examiner informed Applicants' agent that the portion of the specification Applicants referred to in the Reply mailed August 22, 2003 was on page 66, line 9-11. The Examiner further notes that there is nothing to support the idea that (C_1-C_6) is intended to cover "alkylene", "alkenylene" and alkynylene" and that "C_1" is not consistent with unsaturated groups. The Examiner invites Applicants to provide guidance in the specification.

Applicants respectfully direct the Examiner's attention to page 66, lines 9-11 of the instant specification wherein it states:

> As used herein, aliphatic groups or notations such as "(C_0-C_6)" include straight chained, branched or cyclic hydrocarbons which are completely saturated or which contain one or more units of unsaturation.

As stated above, "(C_1-C_6)" is the same type of notation as (C_0-C_6) and refers to aliphatic groups which are completely saturated or which contain one or more units of unsaturation. For example, the phrase as it currently reads is intended to cover not only alkyl and "alkylene" but also "alkenylene" and "alkynylene", among others as encompassed by the definition given above. Based upon this definition, Applicants submit that the moiety "(C_1-C_6)" is not indefinite and is clear and definite according to the definition in the specification. With respect to the Examiner's comment that "C_1 is not consistent with unsaturated groups", Applicants respectfully point out that one skilled in the art would understand that C_1 can only refer to methyl and that C_2 is the first instance than can include a double or triple bond. In addition, Applicants respectfully point out that the Examiner rejected the same phrase, "(C_1-C_6)"in the parent application, now issued as U.S. Patent 6,660,744. Applicants responded to that rejection and the rejection was withdrawn.

Accordingly, this rejection under 35 U.S.C. §112, second paragraph, is obviated and should be withdrawn.

The Examiner alleges that in claims 36 and 37 the phrase "biologically active metabolites" is not clear. Without conceding the correctness of the foregoing rejection and for the sole purpose of advancing the prosecution of the instant application to place it in condition

for allowance, Applicants have deleted the phrase "biologically active metabolites" from claim 37, renumbered as claim 36, and claim 128. Applicants point out that claim 36, renumbered as claim 35, was cancelled to overcome a rejection under 35 U.S.C. §112, first paragraph, as stated above.

b. The Examiner alleges that in claim 120, the term "radiation" is not a disease, but a process. Without conceding the correctness of the foregoing rejection and for the sole purpose of advancing the prosecution of the instant application to place it in condition for allowance, Applicants have deleted the term "radiation" from claim 120, without waiver or prejudice to Applicants' right to file a continuation application directed to the canceled subject matter.

Based upon the foregoing, the rejection of claims 36-37 and 120 under 35 U.S.C. §112, second paragraph, is obviated and should be withdrawn.

The Examiner has rejected claims 1-34 and 36-45 and 47-88 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-86 of U.S. Patent No. 6,660,744 (Hirst et al.). The Examiner states "Although the conflicting claims are not identical, they are not patentably distinct from each other because there is significant overlap of the invention." Applicants point out that the instant application has the same chain of priority as the '744 patent and, thus, will expire on the same date. Applicants also note that both the '744 patent and the instant application are owned by the same owner. Applicants herewith submit a terminal disclaimer in compliance with 37 CFR 1.321(c). Therefore, the rejection of Claims 1-34 and 36-45 and 47-88 under the judicially created doctrine of obviousness-type double patenting over claims 1-86 of U.S. Patent No. 6,660,744 is obviated and should be withdrawn.

No fees are due for the instant amendment since the total number of claims after entry of the amendments hereinabove is not more than the total number of claims that Applicants have paid for to date.

Based upon the foregoing, Applicants believe that claims 1-34, 36-114, 116-120, 124-125, 127-138 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that there are any issues that could be resolved in a telephone conference, Applicants invite the Examiner to call Applicants' undersigned agent.

Respectfully submitted,

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